



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/670,867

09/25/2003

Masahiro Suzuki

20241/0207058-US0

5798

7278

7590

07/14/2008

DARBY & DARBY P.C.

P.O. BOX 770

Church Street Station

New York, NY 10008-0770

EXAMINER

HAGOPIAN, CASEY SHEA

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

07/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/670,867	<b>Applicant(s)</b> SUZUKI, MASAHIRO	
	<b>Examiner</b> Casey S. Hagopian	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3,4 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,4 and 9-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Receipt is acknowledged of applicant's Request for Continued Examination filed 4/16/2008 and Amendment/Remarks filed 12/14/2007.

Claims 1, 2 and 5-8 are cancelled. Claim 12 is new. Claims 3 and 11 have been amended. Thus, claims 3, 4 and 9-12 are currently pending.

### **MAINTAINED REJECTIONS**

The following rejections are maintained from the previous Office Action dated 10/22/2007:

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 3, 4 and 9-11 stand rejected and new claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (USPN 5,980,926) in view of Hoy et al. (USPN 5,208,030).**

Suzuki teaches a water dispersible granule formulation and method of making thereof. Specifically, Suzuki teaches a method of making said water dispersible granule by a) admixing an active agent (e.g., triflumizole), a wetting and dispersing agent (e.g., tristyryl phenyl ether, ethylene oxide, sodium polycarboxylate), and water and subjecting the mixture to wet granulation to produce "WDG-SC" with an average particle size of 1.5 microns; b) admixing a wetting and dispersing agent (e.g., sodium alkylnaphthalenesulfonate, sodium alkylbenzenesulfonate, a formaldehyde condensate of sodium liginsulfonate), mineral carriers (e.g., diatomaceous earth and potassium chloride) and subjecting the mixture to dry milling to produce "WDG-WP"; c) mixing "WDG-SC" and "WDG-WP" and then granulating and drying the mixture (Example 1). Suzuki also teaches that "any pesticide which is in solid at an ambient temperature, is hardly-soluble in water and preferably has a solubility in water as much as 2000 pm can be used as the pesticidal component usable in the present invention without any limitation, and more than 2 pesticidal components may be used in combination" (col. 2, lines 40-45). Suzuki also teaches particular pesticides including triflumizole, thiuram, fluazinam, anilazine, captan, hexythiazox, benzoximate, tebufenpyrad, ziram, thiophanate-methyl and benzamideixime compounds represented by a general formula (1) (col. 2, lines 45-60).

With respect to the dry milling step, Suzuki is silent to a second active ingredient that is an agricultural chemical selected from the group consisting of an insecticide, fungicide or herbicide.

Hoy teaches a method of making a dosage device comprising dry milling at least one active ingredient to an average particle size of less than 5 microns. Hoy also teaches that any active ingredient may be used, especially a pesticide, such as an insecticide, herbicide, fungicide or the like (col. 1). Hoy further teaches the particular active agents, thiophanae methyl, captan, thiram, and hexythiazox (col. 1; claim 7) as well as incorporating wetting/dispersing agents and absorptive carriers such as the particular mineral carriers, diatomaceous earth or clay (col. 2). Because both references teach products comprising various pesticides that utilize similar ingredients and include similar methods for the same purpose, it would have been obvious to one skilled in the art at the time the invention was made to include another active agent, such as a pesticide, in order to achieve the predictable result of eliminating a wider range of pests and/or fungi. Additionally, it is desirable from an economic standpoint to have one multi-purpose dosage device. Thus, in Suzuki it would have been obvious to one of ordinary skill in the art at the time the invention was made to include another active, such as a pesticide, in the dry milling step as suggested by Hoy.

Suzuki is silent to the average particle size of about 3 microns to about 30 microns of the second active agent.

Hoy teaches an active ingredient dosage device and a method of making said device (col. 1, lines 1-9). More specifically, Hoy teaches including "at least one active

Art Unit: 1615

ingredient” and comminuting said active ingredient to an “average particle size of less than 5 microns” (col. 1, lines 10-12). Hoy also teaches “the comminution may be effected by dry milling the active ingredient, e.g. by means of micronization, to the desired particle size” (col. 1, lines 20-23). Also, Hoy teaches the active ingredient can be any suitable active ingredient (col. 1, line 36). It should be noted that Hoy’s “less than 5 microns” reads on the claimed “about 3 to about 30 microns” because they are overlapping ranges. One of ordinary skill in the art would have been motivated to include a particle size of less than 5 microns because said size promotes “effective, accurate and even distribution” of the active ingredient (col. 6, line 33). A practitioner would have reasonably expected an active ingredient with a particle size of less than 5 microns to be evenly distributed when dispersed in water. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the average particle size of about 3 microns to about 30 microns as suggested by Hoy.

### ***Response to Arguments***

Applicant's arguments with regards to the rejection of claims 3, 4 and 9-12 under 35 USC 103 have been fully considered but they are not persuasive.

Applicant argues that Suzuki does not teach a second active ingredient selected from the group consisting of an insecticide, a fungicide and a herbicide and therefore Suzuki provides no suggestion or motivation to include a second active ingredient selected from the group consisting of an insecticide, a fungicide and a herbicide (page 8 of Remarks). Applicant further argues that Suzuki also does not teach a different

Art Unit: 1615

particle size of the second active agent (page 9 of Remarks). Applicant also states the Hoy does not teach, suggest or provide motivation to include a second active ingredient selected from the group consisting of an insecticide, a fungicide and a herbicide having a different particle size (page 9 of Remarks).

In response, it is respectfully submitted that applicant appears to be attacking the references separately. Applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). With regards to the argument that Suzuki does not teach a second active ingredient selected from the group consisting of an insecticide, a fungicide and a herbicide, applicant's attention is drawn to the passage of Suzuki at col. 2, lines 39-50 where Suzuki particularly states that combinations of pesticides are permitted. Thus, the examiner disagrees with applicant's assertion that Suzuki doesn't teach a second active ingredient selected from the group consisting of an insecticide, a fungicide and a herbicide. Suzuki clearly teaches that more than one active agent may be included in the formulation. As discussed in the examiner's rejection above, Suzuki is silent to a second active ingredient that is an agricultural chemical selected from the group consisting of an insecticide, fungicide or herbicide, with respect to the dry milling step, as well as the average particle size of the second active agent being about 3 to about 30 microns. Applicant is also reminded that KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, --

Art Unit: 1615

USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing KSR, 82

USPQ2d at 1396) (available at

<http://www.uspto.gov/web/office/dcom/bpai/prec/fd071925.pdf>). In order to make a

*prima facie* case of obviousness, the examiner must resolve the Graham inquiries,

articulate appropriate factual findings and explain the reasoning that provides a nexus

between the factual findings and the legal conclusion of obviousness. It is respectfully

submitted the examiner has fulfilled these requirements. The secondary reference,

Hoy, teaches a method of making a dosage device comprising dry milling at least one

active ingredient to an average particle size of less than 5 microns. Hoy also teaches

that any active ingredient may be used, especially a pesticide, such as an insecticide,

herbicide, fungicide or the like (col. 1). Hoy further teaches the particular active agents,

thiophanae methyl, captan, thiram, and hexythiazox (col. 1; claim 7) as well as

incorporating wetting/dispersing agents and absorptive carriers such as the particular

mineral carriers, diatomaceous earth or clay (col. 2). As stated in the rejection,

both references, Suzuki and Hoy, teach products comprising various pesticides that

utilize similar ingredients and include similar methods for the same purpose. Thus, it

would have been obvious to one skilled in the art at the time the invention was made to

include another active agent, such as a pesticide, in order to achieve the predictable

result of eliminating a wider range of pests and/or fungi. Additionally, it is desirable from

an economic standpoint to have one multi-purpose dosage device. Thus, in Suzuki it

would have been obvious to one of ordinary skill in the art at the time the invention was

made to include another active, such as a pesticide, in the dry milling step as suggested

Art Unit: 1615

by Hoy. Also, one of ordinary skill in the art would have been motivated to include a particle size of less than 5 microns because said size promotes “effective, accurate and even distribution” of the active ingredient (col. 6, line 33). A practitioner would have reasonably expected an active ingredient with a particle size of less than 5 microns to be evenly distributed when dispersed in water. Thus, it would have also been obvious to one of ordinary skill in the art at the time the invention was made to include the average particle size of about 3 microns to about 30 microns as suggested by Hoy. For these reasons, the examiner finds applicant’s arguments unpersuasive and maintains the position that the combined references render the claimed invention obvious. Thus, the rejection under 35 USC 103 is maintained.

### ***Conclusion***

All claims have been rejected; no claims are allowed.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Casey Hagopian whose telephone number is 571-272-6097. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carlos Azpuru, can be reached at 571-272-0588. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1615

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Casey S Hagopian/

Examiner, Art Unit 1615

/Carlos A. Azpuru/

Primary Examiner, Art Unit 1615